Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte FRANK HINTERMAIER

Appeal No. 2003-2090
Application No. 09/161,196

ON BRIEF

Before PAK, WALTZ, and KRATZ, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

REMAND TO THE EXAMINER

Upon a careful review of the record in this application, we determine that this appeal is not ripe for decision at this time. See 37 CFR § 1.196(a)(2002). Accordingly, we *remand* this application to the jurisdiction of the examiner for action consistent with our remarks below to clarify and correct the record.

The examiner made a final rejection of claims 1, 3, 5, and 7-12 in the Office action dated June 4, 2002, Paper No. 25. In reply

to this final Office action, applicant timely filed a Response, a Declaration under 37 CFR § 1.132 (hereafter the Declaration), and a Notice of Appeal (all dated Nov. 4, 2002, Paper Nos. 26-28). Furthermore, applicant's attorney telephoned the examiner on Sept. 26, 2002, and discussed the Declaration with the understanding that the examiner would consider this Declaration (Brief, page 12).

The examiner has failed to respond to the Response and the Declaration. There is no advisory action in the record before us, nor any statement in the Answer regarding the Response and Declaration (see the Answer, page 2, ¶(4)). There is no indication in the record whether the examiner has considered the Declaration. Furthermore, the file record is devoid of any record of the telephone interview referred to by appellant (Brief, page 12; see *MPEP* § 713.04, 8th ed., Aug. 2001).

In the Answer, page 1, ¶(2), the examiner states that the brief does not contain a statement identifying the related appeals and interferences. This is clearly incorrect (Brief, page 2).

In the Answer, pages 2-3, ¶(9), the examiner lists seven references as "prior art of record relied upon in the rejection of claims under appeal." However, only two of these references are listed in the statement of the rejections (Answer, pages 3 and 4; see the references to Summerfelt et al. and Kawakubo et al.). If

the examiner relies upon any reference, even in a minor capacity, this reference should be included in the statement of the rejection. *See In re Hoch,* 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). Additionally, we note that only two other references are discussed in the entire Answer, in addition to the applied Summerfelt et al. and Kawakubo et al. references (Answer, page 5). Both of these references included in the examiner's discussion appear to be cited with incorrect patent numbers. The examiner's citation of "US60115997" at line 4 on page 5 of the Answer is correctly cited at line 8 of page 5 of the Answer. The examiner's defense of the citation of "US 705,685" on page 5 of the Answer is perplexing since this patent is not cited in the "Prior Art of Record" on pages 2-3 of the Answer. However, the examiner does cite U.S. Patent No. "5,705,685" at line 3 of page 3 of the Answer, without any explanation of this apparent discrepancy (see the Reply Brief, pages 2-3).

The examiner quotes appellant's statement regarding Lyons et al. (U.S. Patent No. 5,990,348) at page 6 of the Answer. As is apparent from the Brief, page 8, and the Reply Brief, pages 3-4, the examiner has misquoted appellant with respect to quoting "group IIB" instead of the correct "group IIIB."

Appellant has submitted several references as evidence that gallium is a Group IIIB element and not a transition element (Brief, pages 9-10; Reply Brief, page 4; see the Response dated Nov. 4, 2002, Paper No. 27).[1] The examiner does not address this countervailing evidence in the Answer.

Upon return of this application to the jurisdiction of the examiner, the examiner should reconsider all the of the cited prior art and state exactly which references are applied to reject any claims, listing every reference even if used only as "evidence" to support the examiner's rationale. *See In re Hoch, supra.* The examiner should make of record any telephone interview. The examiner should also indicate on the record whether the Declaration of Paper No. 26 has been considered, and if so, what weight has been given to this evidence. The examiner should discuss appellant's citation of three references and the weight given these disclosures (Brief, pages 9-10; Reply Brief, page 4).

Pursuant to the provisions of 37 CFR § 1.193(b)(1)(2000), we authorize the examiner to make the above noted corrections and clarifications to the record in a supplemental answer only if no

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[1]Appellant mistakenly states the date of this Response to be either Dec. 4, 2002 (Brief, page 2) or Oct. 4, 2002 (Brief, page 9). We deem this error to be harmless.

new ground of rejection is presented, i.e., only if the examiner relies upon Summerfelt et al. and Kawakubo et al. as the sole evidentiary basis for any rejections on appeal. Otherwise, the examiner must reopen prosecution of this application.

This application, by virtue of its "special" status, requires an immediate action, *MPEP* § 708.01, (D). It is important that the Board be promptly informed of any action affecting the appeal in this application.

REMANDED

CHUNG K. PAK)
Administrative Patent Judge)
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THOMAS A. WALTZ) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
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PETER F. KRATZ)
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